

REMARKS

Claims 1, 18, and 26-44 are pending in this application. Claims 45 and 46 have been added.

The Office Action dated September 2, 2004, and the references cited therein, have been received and carefully reviewed. The issues raised in the Office Action were discussed with the examiner during a personal interview on December 6, 2004, and, as an initial matter, Applicant's representative would like to thank the examiner for the courtesies extended during that interview. Pursuant to MPEP 713.04, a summary of the interview appears below.

INTERVIEW SUMMARY

Claims 1, 26, 32, 38 and 44 were discussed, as were the Nozaki and Hayashi references. The possibility of amending claim 26 to recite a protrusion formed of the same material as the first leg was discussed. It was agreed that claims 1 and 44 appeared to distinguish over the art of record because Hayashi was non-analogous art. The interaction between the first lip and the protrusion was also discussed.

FORMAL REJECTIONS

The examiner objected to certain language in claim 26 which language has been cancelled by the above amendment. It is believed

that the amendments to claims 29 and 33 address the remaining rejections under 35 U.S.C. 112, second paragraph.

SUBSTANTIVE REJECTIONS

35 U.S.C. 102(b)

Claim 26 stands rejected under 35 U.S.C. 102(b) as being anticipated by Nozaki. As amended, claim 26 requires a door glass run having a bottom wall, first and second legs each having an end portion projecting from the bottom wall and first and second lips extending from the end portions toward the bottom wall. Claim 26 further requires that a portion of the first leg include a protrusion having an arcuate first-lip engaging surface. A center portion of the protrusion contacts the first lip at a first point and the door glass at a second point spaced from the first point, such that a distance from the first leg end portion to the second point is greater than a distance from the first leg end portion to the first point. A benefit of this arrangement is discussed in the specification beginning at page 13, line 20 and ending at page 15, line 8. This arrangement is not shown or suggested by Nozaki, and claim 26 and its dependent claims 27-31 and 45 are therefore submitted to be allowably over Nozaki for at least this reason.

Claim 32 stands rejected under 35 U.S.C. 102(b) as being anticipated by Nozaki. Claim 32 as amended requires that a protrusion on a first leg be formed of the same material as the

first leg. Element 46 in Figure 4 of Nozaki is illustrated with stippling while the door glass run is illustrated with cross-hatching which indicates that these elements are formed of different materials. Nozaki therefore does not show a protrusion formed of the same material as the door glass run, and claim 32 and its dependent claims 33-37 are submitted to be allowable for at least this reason.

Claim 38 as amended requires a first leg having a protrusion that engages the first lip at a point closer to the proximal end of the first leg than to the distal end of the first leg. This feature is not shown or suggested by the art of record. Claim 38 and its dependent claims 39-43 and 46 are submitted to be allowable for at least this reason.

35 U.S.C. 103(a)

Claim 1 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Nozaki in view of Hayashi. As discussed during the interview, Hayashi is non-analogous art that would not have been considered by one attempting to solve the problem faced by the present inventor. Alternately, if it is maintained that Hayashi is analogous art, no motivation has been shown for combining the teachings of Nozaki and Hayashi. Each of these points is addressed below.

NON-ANALOGOUS PRIOR ART

"In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." MPEP 2141.01(a) citing *In re Oetiker*, 24 U.S.P.Q. 2d 1443 (Fed. Cir. 1992). In the present case, the problem faced by the inventor was to design a door glass run that produced lower noise levels than known door glass runs and to do so in a manner that did not interfere with the movement of a door glass along the run. This is different than the problem of forming a seal between an automobile door and an automobile frame - Hayashi's field of endeavor. Hayashi and the present inventor were therefore involved in different "endeavors," and Hayashi fails to satisfy the first prong of the analogous art test described above.

The second prong of the analogous art test is to determine whether the problem addressed by Hayashi was reasonably pertinent to the problem faced by the present inventor. Hayashi's problem involved seals between a hinged door and a fixed door frame. Hayashi does not address the problems associated with a moving glass in a door glass run or the problems of noise caused by glass vibration. There would thus be no reason for one developing an improved door glass run to look to references such as Hayashi for a solution.

Hayashi fails to satisfy both the first and second prongs of the *Oetiker* analogous art test, and it is therefore submitted that Hayashi is non-analogous art and should be withdrawn as a reference.

NO MOTIVATION TO COMBINE HAYASHI WITH NOZAKI

Alternately, if the examiner maintains that Hayashi is analogous prior art, it is respectfully submitted that no motivation to combine Nozaki and Hayashi has been identified.

Claim 1 requires a notch having a depth equal to or less than 0.5 mm. While Nozaki includes a notch, the Office Action acknowledges that Nozaki is silent regarding the depth of the notch. Hayashi is cited to show a notch that is 0.5 mm deep. Hayashi, however, is not a door glass run as stated in the Office Action. Hayashi discloses a weather strip that seals a door in an automobile door frame. In order to secure Hayashi's weather strip to a frame, it is necessary to rip off a portion (region "A" in Figure 1) of one of the weather strip lips 35. To this end, a 0.5 mm notch is provided that makes the weather strip easier to tear.

It is respectfully submitted that there is no motivation to take what is essentially a score line for facilitating ripping in the Hayashi reference and use it to perform the function performed by the notch required by claim 1. There is no suggestion in Hayashi that this notch is required for allowing a lip to bend

because lips 33, 34 and 36 (which are not torn off) all apparently bend adequately without a notch. Because no motivation to combine Nozaki and Hayashi has been identified, it is respectfully submitted that claim 1, and its dependent claim 18, patentably distinguish over the art of record.

Like claim 1, claim 44 also requires a notch with a depth less than or equal to 0.5 mm. Claim 44 is submitted to distinguish over the art of record for the same reasons as claim 1.

Conclusion

Each issue raised in the Office Action dated September 2, 2004, has been addressed, and it is believed that claims 1, 18 and 26-46 are in condition for allowance. Wherefore, reconsideration and allowance of these claims is earnestly solicited.

Applicant respectfully petition(s) for a one (1) month extension of time for filing a reply in connection with the present application, and the required fee of \$120.00 is attached hereto.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Scott Wakeman (Reg. No. 37,750) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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